

January 24, 2005
Case No. FR 000029 (7790/353)
Serial No.: 09/817,086
Filed: March 26, 2001
Page 5 of 9

REMARKS/DISCUSSION OF ISSUES

Specification. In the Non-Final Action, Examiner Phu maintained his objection to the amendment of Specification and Abstract filed on April 1, 2004, under 35 U.S.C. §132 as introducing new matter into the disclosure. The Applicant hereby respectfully traverses this objection of the amendment of Specification and Abstract filed on April 1, 2004.

Specifically, in the Non-Final Office Action, Examiner Phu respectfully asserts that the Applicant argument that the specification and abstract do support the added limitation "operation software" in view of the disclosure of PCT WO 97/35453 for updating and modifying the operation software is unsupported, because the Applicant did not incorporate PCT WO 97/35453 by reference in the original specification and Examiner Phu did not find any portion of the specification that clearly discloses that applicant's invention is directly "operation software". The Applicant respectfully disagrees with the aforementioned assertion by Examiner Phu for two reasons.

First, the present application does have a need to rely on any teaching in PCT WO 97/35453 to fulfill its written description, best mode and enablement requirements in accordance with 35 U.S.C. §112. Thus, there is no need to incorporate PCT WO 97/35453 by reference in the original specification.

Second, the original specification clearly states "The invention relates to an apparatus of a certain type comprising a storage device for storing performance data. . . For updating or modifying the operation software of the apparatus, there is proposed in this patent document to utilize a PC type of computer, for example. See, U.S. Patent Application Serial No. 09/817,086 at page 1, lines 1-12. Clearly, the above underlined statement is a portion of the specification that clearly discloses that the applicant's invention is directed to operation software. This is further evidenced by the disclosure of the elements (i.e., operation software) that are stored in a flash memory 45 (FIG. 2) for purposes of determining an operation of an apparatus 1 (FIG. 1). See, U.S. Patent Application Serial No. 09/817,086 at page 2, lines 18-30.

January 24, 2005
Case No. FR 000029 (7790/353)
Serial No.: 09/817,086
Filed: March 26, 2001
Page 6 of 9

Thus, the amendment of the Specification and the Abstract filed on April 1, 2004, did not add new matter to the original disclosure. Withdrawal of the objection to the amendment of Specification and Abstract filed on April 1, 2004, under 35 U.S.C. §132 as introducing new matter into the disclosure is therefore respectfully requested.

Claims 1-7. In the Non-Final Office Action, Examiner Phu rejected claims 1-7 on various grounds. The Applicant responds to each rejection as subsequently recited herein, and respectfully requests reconsideration of the present application under 37 CFR § 1.112:

- A. Examiner Phu rejected claims 1, 5 and 7 under 35 U.S.C. §112, ¶1 as failing to comply with the written description requirement.

The Applicant respectfully traverses this rejection of claims 1, 5 and 7 for the same reason herein the Applicant respectfully traversed herein the objection to the amendment of Specification and Abstract filed on April 1, 2004, under 35 U.S.C. §132 as introducing new matter into the disclosure. Withdrawal of the rejection of claims 1, 5 and 7 under 35 U.S.C. §112, ¶1 as failing to comply with the written description requirement is therefore respectfully requested.

January 24, 2005
Case No. FR 000029 (7790/353)
Serial No.: 09/817,086
Filed: March 26, 2001
Page 7 of 9

- B. Examiner Phu rejected claims 1, 2 and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,062,132 to *Yasuda* et al. in view of U.S. Patent No. 6,771,317 to *Ellis* et al.

The Applicant has thoroughly considered Examiner Phu's remarks concerning the patentability of claims 1, 2 and 5-7 over *Yasuda* in view of *Ellis*. The Applicant has also thoroughly read *Yasuda* and *Ellis*. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify *Yasuda* in view of *Ellis* as proposed by Examiner Phu to yield claims 1, 2 and 5-7. See, MPEP §2143. The Applicant respectfully asserts that Examiner Phu has failed to establish a *prima facie* case of obviousness in view of the fact that *Yasuda* teaches away from the modification of *Yasuda* in view of *Ellis* as proposed by Examiner Phu.

Specifically, as illustrated in FIGS. 1 and 2, *Yasuda* teaches an operation of a predetermined key of a handset unit 1A to transfer non-performance data (e.g., phone numbers) stored in a memory 9 incorporated within handset unit 1A to a memory 9 incorporated within a handset unit 1B whereby the non-performance data that was manually inputted for storage in memory 9 of handset unit 1A can be copied to memory 9 of handset unit 1B with an elimination of the requirement to manually input the same non-performance data into handset unit 1B. See, *Yasuda* at Abstract; column 1, line 67 to column 2, line 11; column 2, line 66 to column 3, line 2; column 3, lines 59-68; column 5, lines 39-50; and column 6, lines 4-19; and column 6, lines 48-61. Thus, at the time of the present invention, one having ordinary skill in the art would have understood the teachings of *Yasuda* were exclusively directed to transferring non-performance data manually inputted by anyone (e.g., a software novice or a software expert) into handset unit 1A to unit handset 1B to thereby eliminate a need for a manual input of non-performance data into handset unit 1B. Conversely, at the time of the present invention, one having ordinary skill in the art would have understood the teachings of *Yasuda* were directed away from transferring performance data (e.g., software of *Ellis*) manually inputted by a software expert into

January 24, 2005
Case No. FR 000029 (7790/353)
Serial No.: 09/817,086
Filed: March 26, 2001
Page 8 of 9

handset unit 1A to handset unit 1B to thereby eliminate a need for a manual input of performance data into handset unit 1B, because it would be have been impossible for a software expert to manually input performance data into handset unit 1A. Thus, *Yasuda* teaches away from "updating means for updating the operation software stored within said storage device via an interfacing with another apparatus of the same type" as recited in independent claim 1, "tapping update data from a second apparatus of the same type as the first apparatus to update the operation software in the first apparatus" as recited in independent claim 5, and "means for exchanging update data for updating operation software stored within a first apparatus, wherein a second apparatus communicates the update data to the first apparatus and the operation software stored within the first apparatus is updated with the update data" are recited in independent claim 7.

Withdrawal of the rejection of claims 1, 2 and 5-7 under §103(a) as being patentable over *Yasuda* in view of *Ellis* is therefore respectfully requested.

- C. Examiner Phu rejected claims 3 and 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,062,132 to *Yasuda* et al. in view of U.S. Patent No. 6,771,317 to *Ellis* et al. and in further view of U.S. Patent No. 6,285,916 to *Kadaba* et al.

Claims 3 and 4 depend from independent claim 1. Therefore, dependent claims 3 and 4 include all of the elements and limitations of independent claim 1. It is therefore respectfully submitted by the Applicant that dependent claims 3 and 4 are allowable over *Yasuda* in view of *Ellis* and in further view of *Kadaba* for at least the same reason as set forth with respect to independent claim 1 being allowable over *Yasuda* in view of *Ellis*. Withdrawal of the rejection of dependent claims 3 and 4 under U.S.C. §103(a) as being patentable over *Yasuda* in view of *Ellis* and in further view of *Kadaba* is therefore respectfully requested.

January 24, 2005
Case No. FR 000029 (7790/353)
Serial No.: 09/817,086
Filed: March 26, 2001
Page 9 of 9

SUMMARY

Examiner Phu's rejections of claims 1-7 have been obviated by the remarks herein overcoming the new matter rejection and supporting an allowance of claims 1-7 over *Yasuda* in view of *Ellis*. The Applicant respectfully submits that claims 1-7 as listed herein fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested. If any points remain in issue that may best be resolved through a personal or telephonic interview, Examiner Phu is respectfully requested to contact the undersigned at the telephone number listed below.

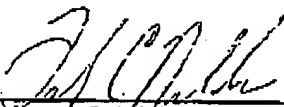
Dated: January 24, 2005

Respectfully submitted,
Jean-Michel Simon

PHILIPS INTELLECTUAL PROPERTY
& STANDARDS
P.O. Box 3001
Briarcliff, New York 10510
Phone: (914) 333-9612
Fax: (914) 332-0615

Jack D. Slobod
Registration No. 26,236
Attorney for Applicant

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113


Frank C. Nicholas
Registration No. 33,983
Attorney for Applicant